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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/673,987	01/08/01	INNES R	JAMES 46.001

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EXAMINER	
CLARDY,S	
ART UNIT	**PAPER NUMBER**
1616	6

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No. 09/673,987	Applicant(s) Innes
	Examiner Mark Clardy	Art Unit 1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jan 8, 2001* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42,* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, a* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-49 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/NZ99/00047, filed April 21, 1999. This application possesses unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

Applicants' claims are drawn to agrochemical compositions, methods of making them, and methods of use, comprising:

a) monoterpene[1] alcohol: a pine oil with at least 60% alcohol content

b) a fatty acid soap: an alkali metal salt of a tall oil and/or a fatty acid,

c) optional monocyclic monoterpene aldehydes, ketones, or other materials[2],

d) optional adjuvants and active agents[3].

wherein there is sufficient fatty acid soap or foam enhancing agent to form a surface monolayer of bubbles when used.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is advised that should claim 14 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight

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[1]Claim 8: pinenes, terpineols, borneols, isoborneols, eucalyptus oil, citronellol, liminol, citrus oils

[2]Claim 9: anethols, fenchols, limonenes, camphenes, thujols, dipentes, eugenols, phellandrenes, cavracols

[3]Claim 17: surfactants, foaming agents, emulsifiers, pesticides fungicidal agents, and fertilizer

difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Composition laim 15 differs from parent composition claim 14 in specifying how the composition is to be used. Such a limitation does not change the scope of the composition itself, thus the compositions of these claims are identical.

Claims 17 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, the claims recite the broad recitation "pesticide", and also recite "fungicide" which is the narrower statement of the range/limitation.

Claim 15 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 15 refers to a test procedure, but does not further limit the composition of claim 14 itself.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1 and 2 are rejected under 35 U.S.C. 102(a), (b), and (e) as being anticipated by Comparative Example 1b of Barranx et al (US 5,763,468).

Barranx et al teaches disinfectant compositions comprising at least one terpene alcohol and at least one bactericidal acidic surfactant. Comparative Example 1b comprises 20% pine oil and 20% tall oil sodium fatty acid soap. The pine oils used in the patent have a terpenic alcohol content of 88-93% (col 5, lines 26-31)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19, 21-25, 28-29, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Barranx et al and Richter (US 5,728,672).

The disinfectant compositions of Barranx et al has been discussed above.

Richter teaches pine oil (columns 2-3) cleaning compositions (Abstract) which may also contain anionic surface active agents including fatty acid (C_{8-20}) salts (col 9, lines 24-28).

One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of combining terpene or pine oil components with soap materials in disinfectants.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in combination as disinfectant compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the disinfectant art. None of applicants' pesticidal methods have been rejected over these references.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Pullen et al (US 5,753,593) and Evans et al (US 5,948,731).

Pullen et al teach the utility of terpene oils such as pine oil, among others (col 2, lines 4-13), in combination with surfactants, preferably the salts of fatty acids (col 3, lines 14-20), as aquatic herbicidal agents.

Evans et al teach that fatty acid salts were known herbicidal agents.

One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of fatty acid salts in herbicidal compositions.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in herbicidal compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the herbicidal art.

No unobvious or unexpected results are noted; no claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

S. Mark Clardy

S. Mark Clardy
Primary Examiner
AU 1616

August 27, 2001